UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,546	09/16/2002	Rick Roland Langmaid	17480P024	6595

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Blakely Sokoloff Taylor & Zafman
12400 Wilshire Boulevard 7th Floor
Los Angeles, CA 90025-1026

EXAMINER
OBEID, FAHD A

ART UNIT	PAPER NUMBER
3627	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/088,546	LANGMAID ET AL.
	Examiner	Art Unit	
	FAHD A. OBEID	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _16 March 2009_.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1,2,4-11,13-20 and 22-27_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-2, 4-11, 13-20, and 22-27_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

1.   **Claims 1-2, 4-11, 13-20, and 22-27** are pending in this application.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 03/16/2009 has been entered.

Preliminary Remarks

3.   This is in reply to application filed on 03/16/2009.

4.   Claims 3, 12, 21, and 28 have been cancelled.

5.   Claims 1, 10, 19, and 27 have been amended.

6.   No claims have been added.

7.   Claims 1-2, 4-11, 13-20, and 22-27 are currently pending and have been
        examined.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim elements "means for receiving", "means for processing", and "means for generating" are means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. There is insufficient disclosure of the corresponding structure, material, or acts for performing the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function,

without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts,

which are implicitly or inherently set forth in the written description of the specification,

perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§

608.01(o) and 2181.

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions
> and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and

recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular

machine or (2) transform underlying subject matter (such as an article or materials) to a different

state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S.

175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S.

63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a

claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim

should positively recite the particular machine to which it is tied, for example by identifying the

apparatus that accomplishes the method steps, or positively recite the subject matter that is being

transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a

transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

8.   Claim 19 is rejected because claiming a software, program, instructions, code, or a data structure without any recitation of a proper computer readable medium is not statutory. To be statutory, examiner suggest to recite the claim as follows; a program/software stored in a computer readable medium executed by (a computer/processor, or any apparatus the applicant is claiming) to perform... etc.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11.   Claims 1-2, 4, 6, 9-11, 13, 15, 18-20, 22, 24, and 27 rejected under 35 U.S.C. 103(a) as

being unpatentable over Stephens (5237159) in view of Doyle (US 5694551), and further in

view of Cahill (US 5,678,046).

12.   Regarding Claims 1, 10, and 19: Stephens discloses an account method, executed by an

account system, including:

- receiving account data (abstract, fig. 4A-4B, col 4 lines 6-36, col 6 lines 12-27, and claim

  8) over a communications network (col 5 lines 22-29 and claim 8), said account data

  having been extracted in a first predetermined format from an accounting software

  package of a remote computer system of a client (abstract, col 3 lines 32-45, col 7 lines

  35-60, claim 1, claim 8, and claim 15);

- processing said account data for storage in a database system in a second predetermined

  format and in a predetermined form based on parameters for the client (claims 8, 15, 21,

  & 33).

Stephens does not explicitly disclose generating customer account information including

statement data for respective customers.

However, Doyle does disclose the following:

- generating customer account information, including statement data, from said account

  data in said database system for respective customers of said client (fig. 1, 15B, abstract,

  col 1 lines 50-52, col 4 lines 21-28, col 8 lines 4-15, and claim 1).

Stephens does not explicitly disclose parameters defining business rules and variables for said

client wherein business rules control account data processing.

However, Cahill does disclose parameters define business rules and variables for said client, and said business rules control said account data processing (col 7 lines 32-40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Doyle's and Cahill's teachings in the Stephens "electronic check presentment system", for the advantage of preparing and submitting an itemized invoices for all the delivered products to the customer (Doyle; col 1 lines 50-52). Also, to allow clients to specify thresholds based on preferences.

13.   Regarding Claims 2, 11, and 20: Stephens discloses an account processing method as claimed in claim 1, including extracting said account data in said first predetermined format (abstract, col 3 lines 32-45, col 7 lines 35-60, claim 1, claim 8, and claim 15).

14.   Regarding Claims 4, 13, and 22: Stephens discloses an account processing method as claimed in claim 1, wherein said generating step includes sending said account data to a printing system and printing (col 7 lines 5-17, col 7 lines 50-59, col 8 lines 64-68, and col 9 lines 33-40), sorting (col 3 lines 28-31, col 9 lines 43-52, and fig. 6) inserting in envelopes said account information for said customers (col 2 lines 39-49).

15.   Regarding Claims 6, 15, and 24: Stephens discloses an account processing method as claimed in claim 1, wherein said generating step includes sending the account information to said customers by electronic transmission media, including email, fax and electronic funds transfer (EFT) systems (col 2 lines 64-68, col 7 lines 55-60, claim 32, and claim 44).

16.   Regarding Claims 9, 18, and 27: Stephens discloses an account processing method as

claimed in claim 3, wherein said processing includes filtering (claim 34 and claim 35), and

verifying said account data (col 9 lines 59-68, col 10 lines 60-68, claim 2, and claim 8) executing

said business rules on said account data using said variables and delivery point identifier (DPID)

and optical mark recognition (OMR) processing (col 5 lines 65-68, col 6 lines 1-11, col 9 lines

59-68, col 10 lines 41-49).

17.   Claims 5, 8, 14, 17, 23, and 26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Stephens (5237159) in view of Doyle (US 5694551).

18.   Regarding Claims 5, 14, and 23: Stephens discloses an account processing method as

claimed in claim 4, wherein said account information includes statements, cheques (fig. 2, col 7

lines 43-60, col 9 lines 33-40, col 12 lines 1-10, col 12 lines 54-65, and claim 13). Stephens does

not disclose invoice as account information.

However, Doyle discloses invoices as account information (col 4 lines 21-28, col 8 lines

16-28).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to use Doyle's teachings in the Stephens electronic check presentment

system enabled. Since, it provides to the clients a summary of their order information.

19.   Regarding Claims 8, 17, and 26: Stephens discloses the claimed invention except for a

transaction module for inputting payment instructions from customers corresponding to the

account information, and executing a payment transaction on the basis of the instructions.

However, Doyle discloses a transaction module for inputting payment instruction from

customers corresponding to the account information, and executing a payment transaction on the

basis of the instructions (col 2 lines 20-67, col 3 lines 15-53, col 11 lines 4-12).).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to use Doyle's teachings in the Stephens electronic check presentment

system enabled. Since, access is provided to the file (account) for agents to perform one or more

activities related to the data inputs, such as entering, deleting, reviewing, adjusting, and

processing the data inputs.

20.   Claims 7, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stephens (5237159) in view of official notice.

21.   Regarding Claims 7, 16, and 25: Stephens discloses an account processing method as

claimed in claim 1, including making said account information available to customers via a

software interface accessible over a communication network including the internet (col 2 lines

32-38, and col 6 lines 52-68). Stephens however, does not disclose Internet as a communication

network.

The Official Notice taken by the Examiner in the Office Action mailed 07/23/2007 is

taken to be admitted prior art because applicant either failed to traverse the examiner's assertion

of Official Notice or the traverse was inadequate (MPEP2144.03[C]).

The Examiner took Official Notice that it is notoriously old and well known to include internet as a communication network (hereinafter Admitted Prior Art).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include internet in the communication system enabled; for the advantage of providing network communication services to users to facilitate and transmit data files in the most accurate and convenient matter.

Response to Arguments

22.   Applicant's arguments with respect to claims 1, 10, and 19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/
Examiner, Art Unit 3627
May 11, 2009

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627